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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on March 28, 2006

Signature

Typed or printed name

Patricia A. Wenger

Application Number

09/881,527

Filed

June 14, 2001

First Named Inventor

Jill Leslie Gizzio

Art Unit

3629

Examiner

T.L. Smith

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

42,218

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

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Typed or printed name

610-566-3040

Telephone number

March 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Jill Leslie Gizzio

Serial No.: 09/881,527

Filed: June 14, 2001

For: Method and Apparatus for Matching Pets to Appropriate Pet Products and Supplies

Group Art Unit: 3629

Examiner: Traci L. Smith

Honorable Commissioner for Patents
Alexandria, VA 22313-1450:

Pre-Appeal Brief Request for Review

35 U.S.C. section 102(e)

The First and Final Office Actions reject Claim 1 under 35 U.S.C. section 102(e) as being anticipated by Bebiak et al. ("Bebiak.") Examiner rejects Claim 1 in Paragraph 7 of the Non-Final Office Action and Paragraph 14 of the Final Rejection, which include the following statement: "Bebiak teaches assigning codes based on predetermined breed code (C. 3 l.8-10) [and] categorizing a product according to a breed code (C. 3 l 27-30)".

Examiner's rejection is improper because Bebiak relates to creating a specific formula for a specific pet and the breed codes of the current invention are comprised of predetermined criteria for a plurality of breeds of pets.

In addition, Bebiak teaches making a customized pet food in response to information relating to the pet, and Applicant's claims 1 - 7 claim a method of matching a pet with an appropriate product based on predetermined criteria for a plurality of breeds of pets.

Accordingly, claims 1 through 7 clearly are not anticipated by Bebiak.

Final Office Action

The Non-Final and Final Office Actions both Rejected Claims 1-9 under 35 U.S.C. 101 for being directed to non-statutory subject matter. The Final Office Action was mailed on September 28, 2005. On October 17, 2005 *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005), was decided, which struck down the basis on which the 35 U.S.C. 101 rejection of Claims 1-9 was based. Thereafter, the Examiner responded to Applicant's inquiry by indicating that in a response to the Final Office Action, Applicant could state that Examiner withdrew the rejection of claims 1 through 9 under 35 U.S.C. § 101 as failing to be directed to statutory subject matter. Following the *Ex parte Lundgren* decision, Applicant had an interview with the Examiner and filed two after Final Responses and Amendments. Applicant is not aware that Examiner has entered either of the two Responses or Amendments.

Applicant submits that following the *Ex parte Lundgren* decision, Examiner should have issued another Non-Final Office Action because the grounds for rejection had changed, and accordingly, Applicant's position had changed. Applicant submits that at least one of the Responses and Amendments filed after the *Ex parte Lundgren* decision should have been entered, and that at least Claim 2, as amended, should be in condition for allowance.

Reconsideration and favorable action are earnestly solicited.

Date: 3/28/06

Respectfully Submitted,



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